

### REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 59-66, 68-70, and 72-74 are pending in this application. Claims 59 and 72-74 are amended. No new matter is added.

In the outstanding Official Action, Claims 59-60, 62-66, 68-70 and 72-73 were rejected under 35 U.S.C. §102(b) as anticipated by Bickford (U.S. Patent No. 4,117,614); Claim 61 was rejected under 35 U.S.C. §103(a) as unpatentable over Bickford in view of Marx (U.S. Patent No. 3,425,147); and Claim 74 was rejected under 35 U.S.C. §103(a) as unpatentable over Bickford.

Before considering the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103, it is believed that a brief review of the subject matter of the independent claims will be helpful. In this regard, independent Claim 59 is directed to a refrigerator shelf including at least one support panel formed of at least one sheet of glass or plastic. The at least one support panel has a plurality of corners. A plurality of coverpieces, at least one of the coverpieces being a cornerpiece, are positioned to cover only one of the plurality of corners of the at least one support panel. At least a first one of the coverpieces include a first assembling portion projecting from a surface thereof in a first direction outward from a periphery of the support panel. At least a second one of the coverpieces include a second assembling portion projecting from a surface thereof outward from a peripheral of the support panel in a second direction different than the first direction. The assembling portions are configured to cooperate with assembly structure in a refrigerator chassis to mount the shelf in the refrigerator chassis in a substantially horizontal configuration.

Claim 72 is directed to, inter alia, a plurality of cornerpieces, each of the cornerpieces being positioned to cover only one of the plurality of corners of the at least one support panel

and covering in part only two adjacent sides of the panel, the plurality of cornerpieces covering an entire periphery of the at least one support panel when assembled.

Claim 73 is directed to, inter alia, at least one of the plurality of coverpieces being adapted to slip or slide in another one of the plurality of coverpieces so as to form a telescopic set of coverpieces.

Independent Claim 74 is directed to, inter alia, a method of manufacturing a refrigerator shelf. A support panel having a plurality of corners is provided. A plurality of coverpieces are provided. At least one of the coverpieces is a corner piece configured to cover only one of the plurality of corners of the at least one support panel. At least a first one of the coverpieces include a first assembling portion projecting from a surface thereof in a first direction outward from a periphery of the support panel and at least a second one of the coverpieces include a second assembling portion projecting from a surface thereof outward from a periphery of the support panel in a second direction different than the first direction. The assembling portions are configured to cooperate with assembly structure in a refrigerator chassis to mount the shelf in the refrigerator chassis in a substantially horizontal configuration. The plurality of coverpieces are assembled onto the support panel.

With regard to the rejection of Claims 59-60, 62-66, 68-70 and 72-73 under 35 U.S.C. § 102(b) as anticipated by Bickford, this rejection is respectfully traversed.

Bickford does not disclose at least one coverpiece including a first assembling portion projecting from a surface thereof in a direction outward from a periphery of a support panel and at least a second one of the coverpieces including a second assembling portion projecting from a surface thereof and a second direction, the first direction being different than the second direction, where these projections cooperate with a refrigerator chassis structure to mount its disclosed frame as a shelf in a refrigerator chassis in a substantially horizontal configuration.

The previously recited relationship between the claimed refrigerator shelf and the cooperation with the refrigerator chassis was unreasonably read as simply laying the picture frame of Bickford on an existing refrigerator shelf so that the back portion 31 of the frame section 11 was asserted to be readable as the previously claimed attachment portion in the “wherein” clause bridging pages 2 and 3 of the outstanding Action. While this strained and unreasonable interpretation is believed to be improper, Claims 59 and 72-74 have been amended to even more clearly expose this reading of the back portion 31 as the claimed projection to be without merit.

In this last regard, independent Claims 59 and 72-74 all require at least first and second assembling portions that must extend in different directions that are “outward from” the “periphery of the support panel,” not in directions towards and below the support panel as is taught for back portions 31 of Bickford.

In addition, these claims now expressly require that these portions must cooperate with assembly structure in a refrigerator chassis to mount the shelf in the chassis which precludes the outstanding Action interpretation as to simply laying the frame of Bickford on an existing refrigerator shelf already mounted in a refrigerator chassis. *See In re Stencel*, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) as to the propriety of describing the structure of a claimed device (there a “driver”) in terms of the structure imposed upon it by the structure it is designed to cooperate with (there a “collar”) as follows:

As a matter of claim draftsmanship, appellant is not barred from describing the driver in terms of the structure imposed upon it by the collar having plastically deformable lobes. The framework --the teachings of the prior art -- against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited.

The court in *Stencel* further emphasized that:

There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally *Kropa v. Robie*, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents §8.06[1][d] (1987). Such statements often, although not necessarily, appear in the claim's preamble, as in *Stencel*'s claims.

And that:

*Stencel* is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of a driver having the claimed structure and purpose. See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

We conclude that it would not have been obvious to put the Grabovac flats in the Reiland driver unless one had in mind the purpose taught by appellant. This purpose, set forth in the claims themselves, "is more than a mere statement of purpose; and that language is essential to particularly point out the invention defined by the claims." *In re Bulloch*, 604 F.2d 1362, 1365, 203 USPQ 171, 174 (CCPA 1979). See also *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 857 [225 USPQ 792] (1984) (the limitations appearing in the preamble are necessary to give meaning to the claim and properly define the invention).

The Board of Appeals reached a similar conclusion in *Ex parte Nolden*, 149 USPQ 378, 379 (Bd. Pat. App. & Int. 1966) relative to an "adapter" that was claimed in terms of its cooperation with jack structure. In this regard, the Board noted that:

While, obviously, appellant seeks here patent protection on the adapter *per se*, we do not believe that the patentability of the adapter should be gauged independently of its intended use and the problem it is to solve, as set forth in the claim. The claimed functional relationship gives life and meaning to the claimed structure of the adapter.

Marx does not provide the deficiencies of Bickford. Marx discloses eye hook 17 attached to the top border frame element 15. Eye hook 17 is used as a hanger on which to

attach wire. Thus, eye hook 17 must be employed either individually or in a pair projecting in the same direction.

The dependent claims are allowable for at least the reasons discussed above as well as for the individual features they recite.

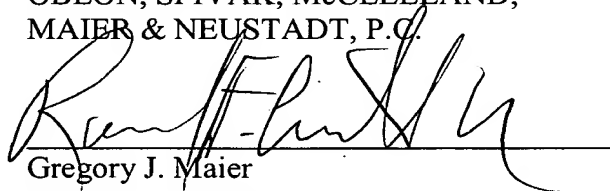
For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance. A Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the telephone number listed below.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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